

REMARKS

Claims 1-27 are pending. Claims 13, 15, and 17 are under examination. The claims have been amended to correct an inadvertent numbering error, as discussed below. Accordingly, these amendments do not raise an issue of new matter and entry thereof is respectfully requested.

Regarding the renumbering of the claims, the original claims inadvertently listed claim 10 twice. In the Restriction Requirement, the Examiner appeared to refer to the claims as renumbered with only one claim 10. Nevertheless, to clarify the record, the claims have been amended to reflect consecutive numbering.

Regarding the Comments Under Election/Restrictions

Under the comments under “Election/Restrictions,” it is asserted “a reference reading on constipation would read on treating arthritis.” Applicant respectfully disagrees with the assertion that a reference reading on treating constipation would read on treating arthritis.

Rejection Under 35 U.S.C. § 102

The rejection of claims 13, 15, and 17 under 35 U.S.C. § 102(b) as allegedly anticipated by JP 363211219 is respectfully traversed. It is respectfully submitted that the claimed methods are novel over this reference.

Applicant respectfully submits that JP 363211219 does not teach the claimed methods directed to treating osteoarthritis, rheumatoid arthritis or acute pain. At best, JP 353211219 describes a composition to prevent dental caries, as acknowledged in the Office Action. However, JP 353211219 does not teach the claimed methods directed to treating osteoarthritis, rheumatoid arthritis or acute pain and, therefore cannot anticipate the claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

The rejection of clam 13, 15 and 17 under 35 U.S.C. § 103 as allegedly obvious over FR 002590589, GB 2072657, Forster et al., U.S. Patent No. 4,640,841, and Ting et al., U.S. Patent No. 6,020,019, taken with JP 363211219 is respectfully traversed.

Applicant respectfully submits that the cited references, alone or in combination, do not teach or suggest the claimed methods directed to treating osteoarthritis, rheumatoid arthritis or acute pain. Firstly, JP 363211219, as discussed above, does not teach or suggest the claimed methods. Secondly, Applicant respectfully disagrees with the assertion that FR 002590589, GB 2072657, Forster et al., and Ting et al. teach the claimed compound. Applicant points out that the claim is directed to a method and not a compound. Furthermore, none of these references, alone or in combination, teach or suggest a composition comprising a therapeutic quantity of a COX-2 inhibitor having an IC50-WHMA COX-2/COX-1 ratio ranging from about 0.23 to about 3.33 with reduced gastrointestinal and cardiovascular toxicity, let alone a method of treating osteoarthritis, rheumatoid arthritis or acute pain using such a composition. At best, the combination of references may suggest the use of different compositions than those recited in the claims to treat dental caries but in no way teaches or suggests the claimed methods. Therefore, Applicant respectfully maintains that JP 363211219, alone or in combination with FR 002590589, GB 2072657, Forster et al., and/or Ting et al., does not teach or suggest the claimed methods. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Conclusions

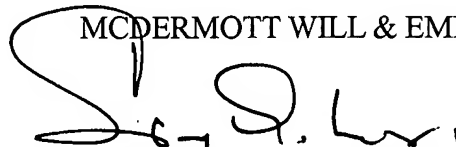
In light of the amendments and remarks herein, Applicant submits that the claims are now in condition for allowance and respectfully requests a notice to this effect. The Examiner is invited to call the undersigned if there are any questions.

A Request for a One (1) Month Extension of Time, up to and including November 6, 2004 is included herewith. Pursuant to 37 C.F.R. § 1.136(a)(1), the Examiner is authorized to charge any fee under 37 C.F.R. § 1.17 applicable in this instant, as well as in future communications, to Deposit Account 50-1133. Furthermore, such authorization should be treated in any concurrent or future reply requiring a petition for an extension of time under paragraph 1.136 for its timely submission, as constructively incorporating a petition for extension of time for the appropriate length of time pursuant 37 C.F.R. § 1.136(a)(3) regardless of whether a separate petition is included.

This Response is being timely filed on Monday, November 8, 2004, since the due date of November 6, 2004 fell on a Saturday.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'S. A. Levi-Minzi', is written over the firm name.

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